JAN - 8 2010

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

PLENTYOFFISH MEDIA, INC.,	)	
Plaintiff,	)	
	)	
v.	)	**Civil Action No. 1:09cv1152**
	)	
ANH TRAN,	)	
Defendant.	)	

ORDER

The matter is before the Court on defendant's motion to dismiss pursuant to Rule 12(b)(6), Fed. R. Civ. P. The issues have been fully briefed, and the parties, by joint stipulation, agreed to have the matter decided without oral argument. *See Plentyoffish Media, Inc. v. Tran*, 1:09cv1152 (E.D. Va. Dec. 8, 2009) (Order). Accordingly, the motion at bar is ripe for disposition.

I.[1]

Plaintiff is a Canadian corporation with its principal place of business in Vancouver, British Columbia. It is the owner of the trademarks "PLENTYOFFISH, "POF," and "PLENTY OF FISH," which are registered with the U.S. Patent & Trademark Office. Plaintiff uses these marks in its operation of a free online dating website located at the domain name plentyoffish.com. Although plaintiff did not register PLENTYOFFISH in the United States until

[1] The following facts are derived from the complaint and are assumed to be true for the purpose of considering the motion at bar. *See Trulock v. Freeh*, 275 F.3d 391, 399 (4th Cir. 2001). By contrast, it is not appropriate to consider facts that fall outside the complaint that are referenced in defendant's motion to dismiss or in the attached affidavits. *See Fayetteville Investors v. Commercial Builders, Inc.*, 936 F.2d 1462, 1471-72 (4th Cir. 1991) (holding that facts outside pleading may only be considered on motion to dismiss if motion is converted to summary judgment and parties are given notice of conversion and opportunity to respond).

June 12, 2007, it has used the mark in commerce since 2001.

Plaintiff asserts that over 100 million visitors access the plentyoffish.com website each month, making it the most visited online dating website and among the 100 most visited websites in the United States. According to one Internet traffic research firm, the website is responsible for 22.7% of all online dating traffic. Plentyoffish.com generates approximately $10 million in advertising revenue each year. The website has been mentioned in articles published in various nationally-circulated newspapers, such as the New York Times, and on The Today Show and CNN.

Defendant, an individual residing in Virginia, is the domain name registrant of the domain names freedatingfish.com, freedatingsingles.info, and freedatingpersonals.info. More specifically, defendant registered the freedatingfish.com domain name on August 14, 2008, with ENOM, Inc., a domain name registrar headquartered in Washington state, and subsequently began operating a free online dating website at that Internet address.

Prior to defendant's registration of freedatingfish.com, defendant operated a free online dating website at plentyoffishdatingnow.com. This prompted plaintiff to file a complaint under the Uniform Domain-Name Dispute-Resolution Policy ("UDRP") objecting to defendant's alleged use of plaintiff's marks at this domain name[2] with the Internet Corporation for Assigned Names and Numbers ("ICANN"), a non-profit organization that coordinates the use of the Internet's unique address identifiers. Plaintiff's UDRP complaint was ultimately resolved by a settlement, which included defendant's disabling the plentyoffishdatingnow.com website. Yet,

[2] Although ¶¶ 21-22 of the complaint state that defendant's websites used copies of "Defendant's trademarks," the remainder of the complaint makes clear that the UDRP complaints objected to defendant's use of *plaintiff's* trademarks, not *defendant's* trademarks.

the day before the allegedly offending domain name was disabled, defendant registered the freedatingfish.com domain name, which likewise uses the PLENTYOFFISH mark on the face of the website and in its meta data. Thereafter, plaintiff filed a second UDRP complaint as to this second website. Although the complaint does not indicate the disposition of this second UDRP complaint, defendant's motion to dismiss indicates that defendant prevailed.

Finally, plaintiff alleges that, according to an Internet tracking company, the five most frequently used search terms that directed visitors to defendant's website from June-September 2009 were variants of the PLENTYOFFISH trademark. Similarly, the complaint cites one firm's Internet statistics, which state that three of the ten most popular search engine terms that drive Internet traffic to online dating websites are the plaintiff's marks and the plentyoffish.com domain name.

II.

On October 13, 2009, plaintiff filed a verified complaint alleging: (i) trademark infringement (Counts I and II); (ii) trademark dilution (Counts III and IV); (iii) violation of the Anti-Cybersquatting Consumer Protection Act (Count V); and (iv) fraudulent misrepresentation in violation of the Virginia Consumer Protection Act of 1977 (Count VI). Defendant moves pursuant to Rule 12(b)(6), Fed. R. Civ. P., to dismiss the complaint for failure to state a claim upon which relief can be granted. Notably, the Supreme Court has made clear that in considering a motion to dismiss, "the tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions," and that "only a complaint that states a plausible claim for relief survives a motion to dismiss." *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555-56 (2007)).

First, Counts I and II allege that defendant infringes the PLENTYOFFISH mark by using this mark on the freedatingfish.com website, in violation of 15 U.S.C. § 1114(a) and § 1125(a). To survive a motion to dismiss these allegations of trademark infringement, plaintiff must plead facts supporting a plausible inference that "it owns a valid and protectible mark, and that defendant's use of a 'reproduction, counterfeit, copy, or colorable imitation' of that mark creates a likelihood of confusion." *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009).[3] In this case, the complaint meets this standard; it plainly states that plaintiff registered and thus possesses the PLENTYOFFISH mark. This allegation is sufficient at the threshold pleading stage to meet the requirement of pleading ownership of a valid protectible mark. Moreover, the likelihood of confusion requirement is met at the threshold pleading stage, by the allegations (i) that both plentyoffish.com and freedatingfish.com are free online dating websites, and (ii) that defendant uses the phrases "Plenty Of Fishing" and "Plenty of Single Fishes" on the freedatingfish.com website. *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984).[4] In response, defendant argues that plaintiff's marks are only placed on its website by the Google Adwords program, an online advertising service over which defendant has no control. While it is true that the plentyoffish.com domain name is placed on the freedatingfish.com website by Google, the website, as noted *supra*, nonetheless contains the allegedly colorable imitations "Plenty Of Fishing" and "Plenty of Single Fishes," which are sufficiently similar to plaintiff's marks to survive a threshold motion to dismiss. Accordingly, plaintiff has stated a claim upon which relief may be granted as to Counts I and II.

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[3] The Fourth Circuit has also described the test for trademark infringement, as follows: (1) that the plaintiff possess the mark; (2) that defendant use the mark, (3) in commerce, (4) in connection with the sale, offering for sale, distribution, or advertising of goods or services, such that (5) the use of the mark is likely to confuse consumers. *See Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005).

[4] In *Pizzeria Uno*, the Fourth Circuit instructed courts to consider the following factors in determining likelihood of confusion:

> a) the strength or distinctiveness of the mark; b) the similarity of the two marks; c) the similarity of the goods/services the marks identify; d) the similarity of the facilities the two parties use in their businesses; e) the similarity of the advertising used by the two parties; f) the defendant's intent; g) actual confusion.

747 F.2d at 1527.

Next, defendant argues that the complaint fails to state a trademark dilution claim in Counts III and IV under 15 U.S.C. § 1125(c), which requires a claimant to prove: (1) that it owns a famous mark that is distinctive, (2) that the defendant has used the mark in commerce in a manner that dilutes the famous mark; (3) that similarity between the marks gives rise to an association between the marks; and (4) that the association is likely to impair the distinctiveness of the famous mark or likely harm the famous mark's reputation. *See Louis Vuitton Malletier v. Haute Diggity Dog*, 507 F.3d 252, 264-65 (4th Cir. 2007). In this case, plaintiff's complaint includes factual allegations sufficient at this threshold pleading stage concerning these elements. Specifically, plaintiff alleges (i) that the mark has gained national exposure in the media, (ii) that Internet users searching for the PLENTYOFFISH mark are directed to the freedatingfish.com website, (iii) that both parties provide free online dating websites at their respective domain names, and (iv), according to the complaint, defendant's website is "adult-oriented" and thus of a quality or character different from plaintiff's website. Thus, defendant's motion to dismiss must be denied as to these Counts.

In addition, defendant moves to dismiss Count V of the complaint, which alleges a violation of the Anti-Cybersquatting Consumer Protection Act ("ACPA"). *See* 15 U.S.C. §

1125(d). To prove such a violation, plaintiff must plead facts establishing: (1) that defendant had a "bad faith intent" to profit by registering freedatingfish.com; and (2) that the domain name is in fact "identical or confusingly similar to, or dilutive of, the distinctive and famous . . . mark." *Lamparello v. Falwell*, 420 F.3d 309, 318 (4th Cir. 2005) (citation and quotation marks omitted). Here, plaintiff's registration of the freedatingfish.com domain name the day before disabling the plentyoffishdatingnow.com website in the face of a UDRP complaint and settlement clearly supports a plausible inference that defendant acted in bad faith. *See* 15 U.S.C. § 1125(d)(1)(B)(i). Moreover, the complaint sufficiently alleges facts supporting a plausible inference that the freedatingfish.com domain name is likely to be confusing to consumers, as it is sufficiently similar to the PLENTYOFFISH mark. Accordingly, defendant's motion to dismiss Count V must be denied.

Finally, in Count VI plaintiff complains that defendant violated the Virginia Consumer Protection Act of 1977[5] by fraudulently misrepresenting the "source, origin, affiliation, or sponsorship" of defendant's services. Compl. ¶ 70. In the first instance, this "threadbare recital[] of the elements of a cause of action, supported by [a] mere conclusory statement[]," does not survive a motion to dismiss. *See Iqbal*, 129 S. Ct. at 1949. Moreover, an examination of the freedatingfish.com website printout attached to the complaint reveals no attempt by defendant to misrepresent that it is offering plaintiff's services on the freedatingfish.com website.[6] To be sure,

[5] Virginia Code § 59.1-200(A).

[6] It is worth noting that while plaintiff also alleges that its marks appear in the freedatingfish.com meta data, the use of the mark in this manner would not be apparent or even known to a website visitor, and thus no fraudulent misrepresentation would be made to the consumer.

freedatingfish.com uses the concept of "fishing" for dates in advertising its services,[7] yet this use does not amount to a misrepresentation as contemplated by the Virginia Consumer Protection Act. Put simply, defendant's reference to the fact that there are "plenty of fish in the sea" does not impermissibly dupe the consumer into believing he has purchased a good or service that was in fact not the good or service described to him by the seller. *See, e.g., Lambert v. Downtown Garage, Inc.*, 555 S.E.2d 714 (Va. 2001) (finding no violation of the Act because seller of a vehicle did not make a misrepresentation about the condition of the vehicle). Thus, while it is plausible that a visitor searching the Internet for plentyoffish.com may find himself at freedatingfish.com, and it is also plausible that the visitor may be confused by defendant's use of phrases sufficiently similar to the PLENTYOFFISH mark, neither the complaint nor the attached printout of defendant's website (i) identify any misrepresentation made by defendant that purports to pass off plaintiff's service as his own, or (ii) represents that freedatingfish.com offers free online dating services when it in fact does not. As the exhibit makes this distinction clear on its face, Count VI must be dismissed with prejudice and without leave to amend.

In sum, accepting the facts alleged in the complaint as true—and putting to one side, at least at this time, the extra-complaint facts presented by defendant in his motion to dismiss—plaintiff pleads a plausible claim as to trademark infringement, trademark dilution, and a violation of the ACPA, and thus defendant's motion must be denied as to those Counts. By contrast, plaintiff fails to plead a plausible claim as to Count VI, which alleges a violation of the Virginia Consumer Protection Act.

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[7] *See, e.g.,* Compl. Ex. 4, at 3 ("To fish singles and to fish personals from these fishing dating services is almost the same as you go [sic] fishing in the river. . . . The most famous free dating websites have many of fishes [sic] online who are eagerly looking for dates.").

III.

Accordingly, for the reasons stated herein, and for good cause,

It is hereby **ORDERED** that defendant's motion to dismiss is **GRANTED IN PART** as to Count VI, and **DENIED IN PART** as to Counts I-V.

The Clerk is directed to send a copy of this Order to all counsel of record.

Alexandria, Virginia
January 8, 2010

T. S. Ellis, III
United States District Judge